The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper No. 14

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES



JEFFREY M. **SULLIVAN**,
and DANIEL ANTHONY GATELY

**Junior Party**,
(U.S. Patents 6,015,916 and 6,455,719),
v.

CARSTEN **BINGEL**,
BERTHOLD SCHIEMENZ, and MARKUS GORES

**Senior Party**,
(Application 09/508,057).

Patent Interference No. 104,818 (**MPT**)

Before: SCHAFER, TORCZON and TIERNEY, Administrative Patent Judges.
TIERNEY, Administrative Patent Judge.

**FINAL JUDGMENT AND RECOMMENDATION**
(Pursuant to 37 CFR § 1.662(a) and § 1.659(c))

## I. Judgment on Priority

Sullivan was Ordered to Show Cause "why judgement on priority should not be entered against Sullivan." (Order to Show Cause, Paper No. 62). In response to this Order, Sullivan

"accedes, on the facts presented, to the entry of judgment on priority only against Sullivan and in favor of Bingel. (Paper No. 72, emphasis in original).

Under USPTO practice:

> A party may, at any time during an interference, request and agree to entry of an adverse judgment. ***The filing by a party of a*** written disclaimer of the invention defined by a count, ***concession of priority*** or unpatentability of the subject matter of a count, abandonment of the invention defined by a count, or abandonment of the contest as to a count ***will be treated as a request for entry of an adverse judgment against the applicant*** or patentee ***as to all claims which correspond to the count***. Abandonment of an application, other than an application for reissue having a claim of the patent sought to be reissued involved in the interference, will be treated as a request for entry of an adverse judgment against the applicant as to all claims corresponding to all counts. Upon the filing by a party of a request for entry of an adverse judgment, the Board may enter judgment against the party.

37 C.F.R. §1.662(a), emphasis added. As set forth in the USPTO interference practice rules, Sullivan's concession on priority is treated as a request for entry of an adverse judgment against all Sullivan claims that correspond to the count.

Count 2 is the sole count in interference. (Notice Redeclaring Interference, Paper No. 44). Sullivan is involved in the interference based upon two issued U.S. Patents Nos. 6,015,916 and 6,455,719. All the claims of Sullivan's involved patents correspond to Count 2, i.e., claims 1-18 of U.S. Patent No. 6,015,916 and claim 1 of U.S. Patent No. 6,455,719. As all of Sullivan's claims correspond to Count 2, judgment is entered against all of Sullivan's claims.

During an interference proceeding, the "Board of Patent Appeals and Interferences ***shall*** determine questions of priority of inventions and ***may*** determine questions of patentability." 35 U.S.C. §135(a), emphasis added. Thus, the question of priority of invention lies at the very heart of an interference. Since Sullivan has conceded priority, there is no longer a question of priority

as between Sullivan and Bingel, leaving only certain potential patentability questions.

In light of Sullivan's concession on priority, this interference is terminated at a very early stage in the proceedings.[1]

## II. Sullivan's Preliminary Motions and Recommendation for the Examiner

Sullivan has filed two preliminary motions under 37 C.F.R. §1.633(a) alleging that Bingel's involved claims, i.e., 2 and 4-12, are unpatentable. (Sullivan Revised Preliminary Motion 1, Paper No. 66 and Sullivan Preliminary Motion 2, Paper No. 53). The issues raised by Sullivan's two preliminary motions relate to patentability and the technical issues raised therein are particularly well suited for an examiner's review and consideration.

Based upon the facts presented in this interference, and as Bingel's involved claims are present in a pending U.S. application, a determination as to the patentability of Bingel's claims is best resolved by the examiner. For example, the panel notes that the technology in question relates to metallocene catalyst synthesis, a highly technical field that has not been fully explained on this limited record. Thus, the Board exercises its discretion[2] and recommends that the examiner of Bingel's involved U.S. Application No. 09/508,057 consider the issues raised in Sullivan's preliminary motions.

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[1]As the February 17, 2003 date set for opposing these motions has not yet come to pass, no Bingel opposition to these motions has been received by the Board. Furthermore, no cross-examination testimony or replies have been filed with the Board.

[2]37 C.F.R. §1.659(c) provides that:
The Board may make any other recommendation to the examiner or Commissioner as may be appropriate.

In the last decade, Congress has introduced patent term adjustments for time spent in an interference. The current version, codified at 35 U.S.C. §154(b)(1)(C), provides for a day-for-day extension of the applicant's term. In contrast, during ex parte prosecution there is a three-year period for the examiner to complete prosecution and there are automatic limits on the time that the applicant has to act. 35 U.S.C. §154(b)(1)(B) and(b)(2)(C). Consequently, in an interference in which the patentability issues have not been fully developed, once the core issue of priority has been resolved, there is little justification in continuing the interference to develop fully issues that can be administered more efficiently in an examination. 37 CFR §1.601(a) provides that interferences are to be resolved in a "just, speedy an inexpensive" manner. In having the examiner review the patentability issues presented in Sullivan's motions, the Board is mindful of the need to avoid unnecessarily continuing a §135(a) interference proceeding where the question of priority no longer exists.

Additionally, the panel notes that if Sullivan desires, Sullivan may file a protest under 37 C.F.R. §1.291 against Bingel's application.

## III. Bingel's Preliminary Motions

Bingel has two pending preliminary motions. Bingel Preliminary Motion 1 (Paper No. 56) requests judgment against Sullivan claims 10 through 16 of Sullivan's U.S. Patent No. 6,015,916. Bingel Preliminary Motion 2 (Paper No. 57) requests judgment against claim 1 of Sullivan's U.S. Patent No. 6,455,719.

Sullivan has conceded priority as to Count 2. Judgment is entered against all the claims

of Sullivan's U.S. Patent No. 6,015,916 and U.S. Patent No. 6,455,719. Accordingly, Bingel Preliminary Motions 1 and 2 are dismissed as ***moot*** as all of Sullivan's claims of have been determined to be unpatentable to Sullivan.

## IV. Sullivan's Request for Reconsideration

Sullivan has requested reconsideration in-part of the Notice Redeclaring Interference (Paper No. 44). Sullivan's request (Paper No. 50) asks that the Notice be modified by vacating that part of the Notice that granted Bingel Miscellaneous Motion 2 to amend Bingel claim 8. As adverse judgment is entered against all of Sullivan's pending claims, Sullivan's request for reconsideration of Paper No. 44 (Notice Redeclaring Interference) is ***dismissed*** as moot.

Upon consideration of the record, it is:

**ORDERED** that judgment on priority as to Count 2 (Notice Redeclaring Interference, Paper No. 44), the sole count in the interference, is awarded ***against*** Junior Party Sullivan.

**FURTHER ORDERED** that Junior Party Sullivan is not entitled to a patent containing claims 1-18 of U.S. Patent No. 6,015,916 and claim 1 of U.S. Patent No. 6,455,719, which correspond to Count 2 (Paper No. 44, p. 7).

**FURTHER ORDERED** that a copy of this final decision shall be placed and given a paper number in the file of Sullivan U.S. Patent No. 6,015,916, Sullivan U.S. Patent No. 6,455,719 and Bingel, U.S. Application No. 09/508,057.

**FURTHER ORDERED** that Sullivan's Request for Reconsideration of Paper No. 44 is dismissed as moot.

**FURTHER ORDERED** that Bingel Preliminary Motions 1 and 2 are dismissed as moot.

**FURTHER ORDERED** that if there is a settlement agreement, attention is directed to 35 U.S.C. § 135(c) and 37 CFR § 1.661.

**RECOMMENDED** that the examiner of Bingel's involved application review Sullivan Revised Preliminary Motion 1 (Paper No. 66) and Sullivan Preliminary Motion 2 (Paper No. 53) and consider taking any action deemed necessary to ensure the patentability of Bingel's claims.

RICHARD E. SCHAFER )
Administrative Patent Judge )
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RICHARD TORCZON )
Administrative Patent Judge )
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MICHAEL P. TIERNEY )
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